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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |  |
|---|-------------|----------------------|---------------------|------------------|--|
| 10/573,052  | 03/22/2006  | Giovanni Meazza      | 163-689             | 8978             |  |
| 7590  | 06/08/2009  |                      | EXAMINER            |                  |  |
| James V Costigan<br>Hedman & Costigan<br>1185 Avenue of the Americas<br>New York, NY 10036-2601 |             | HAVLIN, ROBERT H     |                     |                  |  |
|   |             | ART UNIT             |                     | PAPER NUMBER     |  |
|   |             | 1626                 |                     |                  |  |
|   |             | MAIL DATE            |                     | DELIVERY MODE    |  |
|   |             | 06/08/2009           |                     | PAPER            |  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/573,052             | MEAZZA ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | ROBERT HAVLIN          | 1626                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 April 2009.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 2 and 13-17 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 2,13 and 17 is/are rejected.  
 7) Claim(s) 2 and 13-17 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

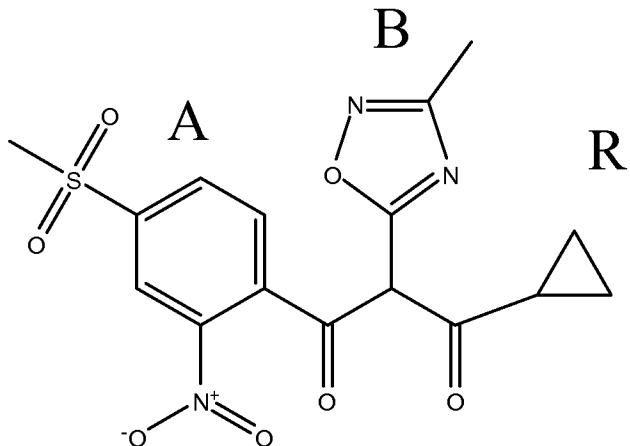
**Status of the claims:** Claims 2, 13-17 are currently pending. Claims 3-12, and 18 were previously cancelled.

**Priority:** This application is a 371 of PCT/EP04/10653 (09/21/2004) and claims foreign priority to ITALY MI2003A 001855 (09/29/2003).

**RCE:** A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/13/09 has been entered.

### *Election/Restrictions*

Applicant previously elected Group I (product of Formula I) and the species of compound No. 22 (Table 1 on page 163):



1-cyclopropyl-2-(3-methyl-1,2,4-oxadiazol-5-yl)-3-(4-(methylsulfonyl)-2-nitrophenyl)propane-1,3-dione

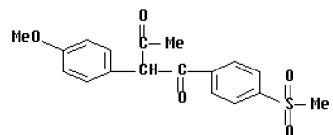
The examiner has searched the elected species; however as described in the following rejections the generic claim (claim 17) encompassing the elected species was not found patentable. Therefore, the claims are restricted to the elected species and the remaining subject matter withdrawn.

**RESPONSE TO APPLICANT'S REMARKS / AMENDMENTS**

***Claim Rejections - 35 USC § 102***

1. Claim 17 was rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al. (STN abstract of WO 9933796).

The prior art teaches the compound:



which anticipated the previous version of the claims when R is Me; B is 4-methoxyphenyl; and A is 4-methylsulfonylphenyl.

Applicant has amended claim 17 so that “D” only reads on heterocyclic groups and no longer aryl. Thus the definition of “B” as “D-(Rx)n” no longer reads on the compound of Yamada et al. cited above.

Therefore this rejection is **withdrawn**.

**NEW CLAIM REJECTIONS**

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

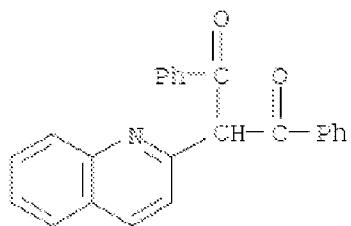
A person shall be entitled to a patent unless –

Art Unit: 1626

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 2, 13, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Chichibabin (CAPLUS Abstract (Accession # 1928:615) of: Chichibabin, A. E., Berichte der Deutschen Chemischen Gesellschaft [Abteilung] B: Abhandlungen (1927), 60B, 1607-17.).

Chichibabin teaches the following compound:



Which anticipates the claim when "A" is phenyl (an aryl group), "B" is 2-quinolinyl ("D" can be heteroaryl), and "R" is phenyl (an aryl group) as described by formula I.

### ***Claim Objections***

4. Claim 2 is objected to because of the following informalities: it does not end with a period. Appropriate correction is required.

5. The pending claims are objected for reading on non-elected subject matter as a result of the restriction to the elected species ONLY.

### ***Conclusion***

The claims are not in condition for allowance.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ROBERT HAVLIN whose telephone number is

(571)272-9066. The examiner can normally be reached on Mon. - Fri., 7:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful the examiner's supervisor, Joe McKane can be reached at (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert Havlin/  
Examiner, Art Unit 1626